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10 Attorneys for Plaintiff

11 OVERTURE SERVICES, INC.

12 UNITED STATES DISTRICT COURT

13 NORTHERN DISTRICT OF CALIFORNIA

14 SAN FRANCISCO DIVISION

15
16 OVERTURE SERVICES, INC., a
Delaware Corporation,

17 Plaintiff,

18 vs.

19 GOOGLE INC., a California Corporation,

20 Defendant.

No. C 02-01991 CRB ADR

21 **PLAINTIFF OVERTURE SERVICES'**
REPLY TO DEFENDANT'S
COUNTERCLAIMS22
23
24 Plaintiff Overture Services, Inc. ("Overture") replies to the counterclaims of
25 Defendant Google Inc. ("Google") as follows:
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27
28

General Allegations

30. Admitted.

31. Admitted.

32. Admitted.

33. Overture is informed and believes that Google is a California corporation with its principal place of business in Mountain View, California, and on that basis admits the allegations in paragraph 33.

34. Admitted.

**First Counterclaim
(Declaratory Judgment of Non-Infringement)**

35. No response is necessary to the allegations incorporated from paragraphs 1 through 10. With respect to the allegations incorporated from paragraph 12, denied. With respect to the allegations incorporated from paragraphs 30 through 34, admitted.

36. Denied.

37. Denied.

**Second Counterclaim
(Declaratory Judgment of Invalidity)**

38. No response is necessary to the allegations incorporated from paragraphs 1 through 10. With respect to the allegations incorporated from paragraphs 14 and 30 through 34, admitted. With respect to the allegations incorporated from paragraphs 15 through 19, denied. As of April 28, 1998, GoTo.com operated a beta or test version of a system then under development, and the beta or test version of a system then under development hosted advertisements as of April 28, 1998, but the beta or test version of a system then under development was not the system claimed by the '361 patent. In addition, Overture cannot respond to Google's information and belief.

39. Denied.

40. Denied.

**Third Counterclaim
(Declaratory Judgment of Unenforceability)**

41. No response is necessary to the allegations incorporated from paragraphs 1 through 10. With respect to the allegations incorporated from paragraphs 14 and 30 through 34, admitted. With respect to the allegations incorporated from paragraph 21, admitted, except as to the characterization of Mr. Davis as the lead named inventor. With respect to the allegations incorporated from paragraphs 15 through 19 and 22 through 29, denied. As of April 28, 1998, GoTo.com operated a beta or test version of a system then under development, and the beta or test version of a system then under development hosted advertisements as of April 28, 1998, but the beta or test version of a system then under development was not the system claimed by the '361 patent. In addition, Overture cannot respond to Google's information and belief.

42. Denied.

43. Denied.

**OVERTURE'S AFFIRMATIVE DEFENSES TO
GOOGLE'S COUNTERCLAIMS**

**First Affirmative Defense
(Failure to State a Claim)**

1. Google's Counterclaims for Declaratory Judgment of Non-Infringement, Invalidity, and Unenforceability fail to state a claim upon which relief may be granted.

**Second Affirmative Defense
(Infringement)**

2. Google is directly infringing, inducing infringement by others, and/or contributorily infringing one or more claims of the '361 patent.

**Third Affirmative Defense
(Validity)**

3. The claims of the '361 patent are valid and enforceable.

**Fourth Affirmative Defense
(Truth of the Statements)**

4. The statements made by Darren J. Davis in the declaration he submitted pursuant to 27 C.F.R. § 1.132 are true.

5. The statements made by John G. Rauch in the Amendment and Remarks submitted with Mr. Davis's declaration also are true.

6. Because these statements are true, there are no false statements to support Google's allegation of inequitable conduct.

**Fifth Affirmative Defense
(Lack of Intent to Deceive)**

7. Mr. Davis did not intend to deceive the U.S. Patent and Trademark Office, including in connection with the submission of his declaration.

8. GoTo.com did not intend to deceive the U.S. Patent and Trademark Office, including in connection with the submission of Mr. Davis's declaration.

9. Counsel for GoTo.com did not intend to deceive the U.S. Patent and Trademark Office, including in connection with the submission of Mr. Davis's declaration or the accompanying Amendment and Remarks.

10. Because there was no intent to deceive the U.S. Patent and Trademark Office, there could be no acts of inequitable conduct.

PRAYER

WHEREFORE, Overture prays for a judgment:

- (a) adjudging that Google has infringed the '361 patent;
- (b) adjudging that the '361 patent is enforceable and not invalid;
- (c) granting a permanent injunction restraining and enjoining Google, and its officers and representatives, from further infringement of the '361 patent during the remaining term thereof;

